



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,815	04/09/2004	Miles Paschini	EWIR-001/03US 300933-2009	9103
23419 7590 05/14/2008 COOLEY GODWARD KRONISH LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW Washington, DC 20001				
EXAMINER				
WINTER, JOHN M				
ART UNIT		PAPER NUMBER		
3621				
MAIL DATE		DELIVERY MODE		
05/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,815

Applicant(s)

PASCHINI ET AL.

Examiner

JOHN M. WINTER

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

The Applicants papers filed on January 25, 2008 is hereby acknowledged.

Election/Restrictions

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15 are drawn towards a method with a PIN associated with a monetary value, classified in class 705 subclass 72.
 - II. Claims 16-21,25 and 26 is drawn is drawn towards a method with a PIN associated with a product or service, classified in class 705 subclass 26.
 - III. Claims 22-24 and 26 is drawn is drawn towards a method of authorization via PIN , classified in class 705 subclass 51.

Inventions I ,II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed in invention III does not require the particulars of the

subcombination as claimed in inventions I or II such as a “monetary value ” or a product; similarly invention II does not require a monetary value as claimed in invention I etc...

Examiner notes that is would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via paper filed on January 25,2008 a provisional election was made without traverse to prosecute the of Invention I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Claims 1-15 have been examined .

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 states “the generating [of the request] is in advance of the receiving of the client request” it is unclear how the terminal can generate the request prior to receiving the request.

Claim 4 is dependant upon claim 3 and is rejected for at least the same reasons. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

invention. Claim 7 states “wherein the first network and the second network comprise a single common network” it is unclear whether the applicant is claiming discrete networks.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being obvious in view of Brody et al. (US Patent 5,350,906) in view of Konya (US Patent 5,350,906).

As per claim 1,

Brody et al. discloses a method of distributing a personal identification number (PIN) through a client terminal, comprising:

generating, at a host connection manager, a request for a PIN, wherein the PIN is associated with a particular monetary value;(Abstract)

transmitting the request for the PIN from the host connection manager to a server;
receiving the PIN at the host connection manager; (Column 7, lines 14-24)

receiving, at a host connection manager, a client request indicative of the particular monetary value,(Figure 3 – step 305 “read amount ”) wherein the client request is generated at

Art Unit: 3621

the client terminal and transmitted to the host connection manager;(Figure 3 -- step 311 send PIN)

Brody et al. does not explicitly disclose "sending the PIN to the client terminal in response to the client request " Konya discloses "sending the PIN to the client terminal in response to the client request " (Column 11, lines 11-26), It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Brody et al. method with the Konya method in order to manage PIN codes from a centralized location; furthermore the combination of these elements does not alter their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention..

As per claim 2,

Brody et al. discloses the method of claim 1

wherein the generating is initiated in response to the receiving of the client request at the host connection manager.(Figure 3 – when the card is read it generates a response request)

As per claim 3,

Brody et al. discloses the method of claim 1

wherein the generating is in advance of the receiving of the client request at the host connection manager. (Figure 1)

As per claim 4

Brody et al. discloses the method of claim 3, further including:
storing, at the host connection manager, the PIN in a PIN cache; and
retrieving the PIN from the PIN cache in response to the receiving of the client request at
the host connection manager. (Column 7, lines 14-24)

As per claim 5
Brody et al. discloses the method of claim 1,
wherein the transmitting the request for the PIN includes
transmitting the request for the PIN via a first network, and wherein the client request is
transmitted from the client terminal to the host connection manager via a second network.
(Figure 1)

As per claim 6
Brody et al. discloses the method of claim 5,
wherein the transmitting the request for the PIN via the first network from the host
connection manager to the server is in accordance with a first communication protocol and
wherein the client request is transmitted to the host connection manager from the client terminal
via the second network in accordance with a second communication protocol.(Column 5, lines
22-36)

As per claim 7

Brody et al. discloses the method of claim 6,
wherein the first network and the second network comprise a single common
network.(Figure 1)

As per claim 8
Brody et al. discloses the method of claim 1,
wherein no inventory of PINs is stored at the client terminal.(Abstract -- temporary Pin
is used)

Claims 9-15 are not patentably distinct from claims 1-8 and are rejected for at least the
same reasons.

Conclusion

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The
examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the
organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Winter
Patent Examiner -- 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621